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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,331	07/02/2001	Eiji Satake	010860	6700

23850 7590 10/09/2002

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EXAMINER

GORR, RACHEL F

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 10/09/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

TC 5

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/895,331	SATAKE ET AL.
	Examiner	Art Unit
	Rachel Gorr	1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 09 September 2002.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

1. Applicant's election without traverse of claims 1-5 in Paper No. 4 is acknowledged.
2. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3 and 4, the word "type" should be deleted. It has been held that when the word "type" is added to an otherwise definite expression, it renders it indefinite (Ex. Parte Copenhaver, 109 USPQ 118).

Claim 2 is confusing. It isn't understood how a molecule could have both isocyanate and isocyanate reactive groups both. The disclosure, page 5, line 7, specifies only at least two active hydrogens.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Voss and Rolando.

Voss discloses dry laminate adhesives (see abstract) comprising a water-borne polyurethane resin, a polyisocyanate crosslinker (col. 3, last paragraph), and a thickener (col. 4, line 20). In col. 3, line 26, he states that he uses the polyurethane of Rolando. Rolando discloses an OH terminated polyurethane (see example 5), which appears to have been prepared the same way and from the same ingredients as the applicants' examples. Voss and Rolando don't specifically disclose softening temperatures or viscosity values for the water-borne polyurethane, but Voss's adhesive has a viscosity of 25-2000cps (col. 5, line7). When a reference discloses all the limitations of a claim except for a property, and the examiner can't determine if the reference inherently possesses the property, the burden of proof is shifted to the applicant.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss and Rolando in view of Itabashi and Emmons.

7. Voss and Rolando disclose the invention of the claims (see above rejection). Voss discloses pigments and dispersing agents for pigments (col. 4, line 21). He differs from the claims by not specifying the thickener as an association polymer, and by not specifying the pigment dispersing agent as a resin.

8. Emmons discloses polyurethane as associative thickeners (col. 7, lines 36-45), and he teaches that less thickener is needed if associative thickeners are used.

9. Itabashi discloses a water dispersible polyurethane pigment dispersing agent (see abstract, col. 2, lines 21-26).

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the associative thickeners of Emmons in the adhesive of Voss in order to thicken the composition with a small amount of thickener. It would have been obvious to use the resin pigment dispersing agent of Itabashi in Voss's adhesive because Itabashi teaches using it for urethane formulations (col. 11, line 27), and Itabashi teaches improved pigment dispersibility (bottom col. 24).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel Gorr whose telephone number is (703) 308-3608. The examiner can normally be reached on Mon., Tues., Thurs., Fri., from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

R.G.  
October 1, 2002

*Rachel Gorr*  
RACHEL GORR  
PRIMARY EXAMINER